REMARKS/ARGUMENTS

The drawings again stand objected to because they do not show the handle comprised of rubber or an elastomeric material. The application contains only planar and perspective views of the handle of the inventive adjustable pipe repair clamp installation tool. There are no sectional views of the handle of this tool. The composition of the tool's handle is disclosed in the application on page 7, line 1, and on page 13, lines 6-7, as preferably comprised of rubber or an elastomeric material. MPEP Section 608.02 dealing with patent drawings, and in particular subsection IX dealing with drawing symbols, includes illustrations for materials having various compositions including rubber. In particular, there are specific provisions for illustrating an element comprised of rubber in a sectional view. However, there is no particular representation for a planar or perspective view of an object comprised of rubber or an elastomeric material specified in this section. Therefore, the representation of a rubber or elastomeric handle for the adjustable pipe repair clamp installation tool shown in the various figures is believed to be correct and in compliance with patent drawing requirements. This same issue arose in related co-pending application Serial No. 10/608,290 and was withdrawn following a similar explanation as provided above which was included in Amendment B filed September 30, 2005 in the aforementioned related application. This application as well as the aforementioned related application are being examined by the same examiner.

Claims 1-26 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-40 in the aforementioned co-pending, related application Serial No.

10/608,290 ('290 application). The two embodiments of an adjustable pipe repair clamp installation tool described and claimed in this application and in the '290 application are fundamentally different in configuration and operation and were designed for use with pipe repair clamps having different designs and configurations.

As described in previously filed Amendment B in this application, clasp 168 recited in pending claim 1 is coupled to a body portion 152 of the apparatus adjacent a first end thereof. This connection is accomplished by means of a pivot/coupling pin 166 as shown in the figures. Pending claim 1 further recites that the clasp 168 is adapted to engage in outer edge of one of the pipe repair clamp's flanges. Claim 1 also recites that a first end 164a of an arm 164 is pivotally coupled to the body portion 152 of the apparatus at a location intermediate the first and second opposed ends of the body portion of the apparatus. Claim 1 further recites that a second opposed end 164c of arm 164 is adapted for insertion in an aperture in a first edge flange of a pipe repair clamp. This arrangement of the claimed adjustable pipe repair clamp installation tool is shown in FIGS. 10-12 of this application.

The apparatus claimed in the aforementioned co-pending application cited by the examiner in the double patenting rejection is illustrated in FIGS. 10-16 in the co-pending application, which figures were attached as Exhibits A-D in Amendment B filed in this application and are also attached to the present amendment to facilitate comparison of the two embodiments of an adjustable pipe repair clamp installation tool which are the subjects of the aforementioned '290 application and the present application.

In the claims of the co-pending '290 application, the clasp 112 which is adapted for

engagement with an edge of a repair clamp flange is recited as pivotally coupled to the tool's body portion 102 intermediate the first and second opposed ends thereof, and not adjacent a first end thereof is shown an attached Exhibits A-D. The arm 110 in the co-pending application is claimed as having a first and pivotally coupled to the body portion adjacent a first end thereof, and a second opposed end adapted for insertion in an aperture in an edge flange of the repair clamp is also shown in attached Exhibits A-D. Thus, while the arm and clasp recited in the two sets of claims describe the arm as adapted for insertion in an aperture in a repair clamp's first edge flange and the clasp as adapted for engaging an outer edge of the repair clamp's outer edge flange, the recited positioning in attaching the arm and clasp to the body portion of the repair clamp installation apparatus is reversed in these two sets of claims. These two applications with different sets of claims were filed to secure claim coverage for the embodiment of the invention shown in FIGS. 10-12 of the present application and the alternative embodiment shown in FIGS. 10-16 of the co-pending '290 application cited by the examiner in the double patenting rejection. Another way to look at these differences between these two embodiments of Applicant's invention is that the arm 164 of the present application includes a hook end 164c adapted for insertion in an aperture in an edge flange of a repair clamp, while the arm 112 in the co-pending application includes an end 112a adapted for engaging an outer edge of an edge flange of the repair clamp, with both arms attached to the body portion of the apparatus at a location between its two opposed ends. In addition, the claimed clasp 168 in the present application includes a clamp end 168b adapted for engaging an outer edge of a repair clamp edge flange, while the clasp 110 in the co-pending '290 application includes a clamp end 110a adapted for insertion in an

aperture in an edge flange of the repair clamp. Thus, the two embodiments disclosed and claimed in this application and in the '290 application are of opposite configuration.

These two embodiments were designed by applicant to accommodate pipe repair clamps of different designs. The pipe repair clamp with which the adjustable installation tool of the present application is intended for use is shown in attached Exhibit E, which is a copy of a brochure describing and illustrating the installation tool of the present invention as well as a pipe repair clamp with which it is intended for use. The pipe repair clamp shown in Exhibit E includes a pair of spaced edge flanges extending the length of the pipe repair clamp and separated by an elongated, linear slot. In Exhibit E, one edge flange is referred to as a "Receiver Bar", while the other edge flange is referred to as a "Stud Bar". Each of the receiver bar and the stud bar includes a respective "Receiver Bar Slot." As in the pipe repair clamp described in the present application, the pipe repair clamp shown in Exhibit E includes three bolt receiving brackets which each include a pair of spaced ribs and an end portion referred to as a "Washer Plate" having three spaced apertures each adapted to receive a respective coupling bolt. The combination of a nut and washer is shown attached to each of the coupling bolts in Exhibit E, with tightening of the nuts resulting in tight engagement between each of the washers and the washer plate. It is in this manner that the repair clamp's edge flanges are drawn together for securely attaching the pipe repair clamp to a pipe in a sealed manner. The adjustable pipe repair clamp installation tool of the present invention shown in Exhibit E includes a pivoting arm having a distal end adapted for insertion in an aperture in one of the clamp's edge flanges. The tool's pivoting clasp attached to one end of the tool includes a hook as shown in Exhibit E for engaging an outer edge of the other

edge flange of the clamp.

As shown in attached Exhibits A-D, the embodiment of the adjustable pipe repair clamp installation tool disclosed and claimed in the co-pending '290 application is not capable of operating with a pipe repair clamp having a washer plate as shown in Exhibit E. The washer plate shown in the pipe repair clamp of Exhibit E prevents the clamp end 112a of the arm 112 of the installation tool 100 shown in Exhibits A-D from engaging an edge of the clamp's edge flange. Tightening of the three bolts of the pipe repair clamp shown in Exhibit E places the washer plate in engagement with the clamp's coupling brackets as well as with the outer edge of the clamp's receiver bar preventing the tool's hooked clamp end 112a from being able to engage the outer edge of the clamp's edge flange. The adjustable pipe repair clamp installation tool shown in attached Exhibits A-D is not capable of attaching a repair clamp to a pipe where the repair clamp includes a washer plate or other structure covering an outer edge of the clamp's edge flange as shown in Exhibit E. Thus, the adjustable pipe repair clamp installation tool disclosed and claimed in the present application was designed for attaching a pipe repair clamp with which the installation tool of the co-pending '290 could not be used. Because the two embodiments of an adjustable pipe repair clamp installation tool claimed in the '290 application and in the present application differ in structure and operation and are designed for use with different pipe repair clamps, they are not directed to the "same invention" and the double patenting rejection should be withdrawn.

Claims 1-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 1,445,286 to Bosco in view of U.S. Patent No. 1,619,749 to Murray.

In rejecting independent claim 26 and a dependent claims 2-25, the examiner has not complied with 37 CFR 1.104(c) (2) which requires of the examiner that "....the particular part relied on must be designated as nearly as practable. The pertinence of each reference, if not apparent, must be clearly explained ....." In the present case, in rejecting independent claim 26 and all of the dependent claims, the examiner has merely repeated the recitations of the various rejected claims in the rejections. The examiner has failed to point out where each of the claimed elements or structures is located in either Bosco or Murray in rejecting independent claim 26 and all of the dependent claims. Moreover, in rejecting claim 18 the examiner relies upon FIGS. 3-6 in the previously relied upon patent to Montgomery, which the examiner indicates as not being relied upon in the present final rejection.

The examiner emphasizes throughout the final rejection that the pipe repair clamp referenced in the preamble of independent claims 1 and 26 is not part of the claimed invention. The issue here appears to be the role that the recitation in the claim preamble of "Apparatus for installing a pipe repair clamp on a pipe", and the structure of the pipe repair clamp, has in determining the limits of the claim. Apparently, it is the examiner's position that this recitation in the claim's preamble should be given no weight in determining the limits of the claim.

The determination of whether a preamble limits a claim is made in a case-by-case basis based on the facts of each case. One must look at the specific claims in question in a particular application to determine the role, if any, the recitations of the preamble have in determining the limits of the claim. "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality'

to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ 2d 1161, 1165-66(Fed. Cir. 1999).*

The preambles of independent claims 1 and 26 are substantially identical and are necessary to give proper meaning to the description of the invention set forth in the body of the claim. Both preambles recite apparatus for installing a repair clamp on a pipe, where the repair clamp includes a generally cylindrical body having first and second opposed edge flanges. The repair clamp is further described as having a slot extending the length thereof for receiving the pipe and positioning the repair clamp about an outer circumference of the pipe, with plural nut and bolt combinations coupled to the edge flanges for drawing the repair clamp tightly about the pipe. Various structures recited in the preamble are discussed in the body of the claim in describing the structure and operation of the inventive apparatus for installing the repair clamp on a pipe. More specifically, the repair clamp installation apparatus is described as having an arm with one end adapted for insertion in an aperture in a first edge flange of the repair clamp. Independent claims 1 and 26 further recite that the repair clamp installation apparatus includes a clasp having an end adapted to engage an outer edge of the other edge flange of the repair clamp. Operation of the repair clamp installation apparatus is described as drawing the repair clamp's edge flanges together for securely maintaining the repair clamp on and in engagement with the pipe to allow the nut and bolt combinations to be tightened for securing the repair clamp to the pipe in a sealed manner. The claimed "adjustable mechanism" in claim1 and the claimed "movable member" in claim 26 are described as being capable of adjusting the spacing between

the arm and the clasp of the repair clamp installation apparatus to accommodate a range of sizes of the repair clamp and diameters of the pipe with which the apparatus is used. The structure recited in the preambles of independent claims 1 and 26 is thus inextricably linked to the structure and operation of the pipe repair clamp installation apparatus described in the body of these claims.

The Court of Appeals for the Federal Circuit considered *In re Stencel, 828F. 2d 751, 4 USPQ 2d 1071,* the question of whether a statement in a claim preamble of purpose or intended use constitutes a limitation for purposes of patentability. The case involved a claim with a preamble reciting a driver adapted to set a joint with a particular threaded lobed collar, where the driver turns the collar until the lobes of the collar are deformed by the driver when the collar is tight against a workpiece, with the collar and bolt then locked together. The question was-to what extent, if any, do these recitations in the claim preamble limit the claimed invention. The Court ruled that recitation in the claim preamble of the collar having plastically deformable lobes on its longitudinal exterior was more than a mere statement of purpose and that language is essential to particularly point out the invention defined by the claims. The Court thus concluded that the limitations appearing in the preamble were necessary to give meaning to the claims and properly define the invention. This is the same set of circumstances that we have in the present case. In this case, the pending claims are directed to apparatus for installing a repair clamp on a pipe, with various details of the repair clamp recited in the preamble and then repeated in the body of the claim to give the claim meaning in terms of the components and operation of the claimed apparatus. To ignore these recitations in the body of the claim would render the claim

without meaning and incapable of defining the invention. Thus, to give the pending claims "life, meaning, and vitality", the recitations in the claim preamble must be read as if in the balance of the claim where they are discussed in terms of the structure and operation of the invention.

In rejecting the two pending independent claims 1 and 26, the examiner relies upon the patent to Bosco as disclosing a body portion 13 having first and second opposed ends, and an arm 14 having a first end pivotally coupled to the body portion intermediate the first and second opposed ends thereof, with the arm further including a second opposed end adapted for insertion in an aperture in a first edge flange of a pipe repair clamp. The examiner further relies upon Bosco as disclosing a clasp 15 pivotally coupled to the body portion 13 adjacent the first end thereof and adapted to engage an outer edge of a second edge flange of the repair clamp when the body portion is in a first position relative to the arm and clasp and the repair clamp is loosely disposed about the pipe, wherein pivoting displacement of the body portion about the arm and clasp to a second position draws the repair clamp's edge flanges together for securely maintaining the repair clamp on and in engagement with the pipe and allowing nut and bolt combinations to be tightened for securing the repair clamp to the pipe in a sealed manner. The examiner acknowledges that Bosco does not disclose an adjustable mechanism.

The examiner relies upon Murray as relating to clamps and disclosing an adjustable mechanism, with the Examiner alleging that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an adjustable mechanism to provide a dead lock for the lever when in operation, as taught by Murray.

The patent to Bosco discloses an adjustable clamp including an elongated flexible

element, such as a flat metal strip 3, for positioning about and retaining in position a concrete form comprised of plural planks 1 arranged in edge-to-edge abutting contact. The concrete form is of the type used in building concrete columns, joists and girders. See page 1, lines 8-12. Opposed ends of the flexible element 3 are respectively attached to first and second interlocking members 4 and 5 which are arranged in telescopic engagement. Each of the interlocking members 4, 5 includes a pair of spaced slots 7 adapted to receive and engage respective opposed ends of the flexible element 3. Thus, the form clamp of Bosco does not function as a repair clamp, but rather as a retaining mechanism for a concrete form comprised of plural abutting, aligned planks 1. The manner in which the interlocking members 4 and 5 are attached to opposed ends of the flexible element 3 at any point along its length provides the clamp with adjustability to accommodate molds of various sizes. See page 1, lines 81-85. Thus, it is the clamp in Bosco which is adjustable in size and not a tool 6 for installing the clamp, as in the claimed invention which is directed to an adjustable tool, or apparatus, for installing a repair clamp on a pipe. A tool 6 is used to install Bosco's form clamp, but this tool is not adjustable as is the claimed tool.

Bosco's tool 6 comprises a lever arm 13 having arranged at one end thereof oppositely disposed claws 14 and 15 which are pivotally mounted by means of respective pins 16 and 17 to the lever arm. The axes of pivot pins 16, 17 are spaced apart from one another, so that the claws 14, 15 are drawn inwardly toward each other by movement of the lever arm 13 in one direction with either one or both of the pivot pins serving as a fulcrum for the lever. In operation, tool 6 is applied to interlocking members 4 and 5 of the concrete form clamp, with a pair of claws 14

engaging a pair of lugs 10 extending from the first interlocking member 4 and a pair of claws 15 engaging lugs 8 extending from the second interlocking member 5 as shown in the figures. By pivotally displacing lever arm 13 about either pivot pin 16 or pivot pin 17, flexible element (steel strap) 3 is tightened by drawing together the first and second interfitting members 4, 5 into position to permit the insertion of a locking pin 12, such as a nail, through aligned apertures 11 in the interfitting members. Locking pin 12 is inserted through aligned apertures and driven into a batten 2 of the mold, allowing the detachable tool 6 to be removed while the clamp engages and holds the concrete form together. Thus, Bosco's clamp is secured to the structure being clamped by inserting a locking pin 12 through the clamp's interfitting members 4, 5 and into a batten 2 of the mold. See page 1, lines 96-103. The spaced apertures 11 in the two interfitting members 4 and 5 are not disclosed as providing an adjustable feature to accommodate concrete molds of different sizes as this feature is provided by changing the length of the flexible metal strap 3 between the two interlocking members 4 and 5. See page 1, lines 13-21. The close spacing of the pin receiving apertures 11 in the interfitting members 4 and 5 with respect to the width of the planks 1 of the concrete mold would not afford a size adjustable feature. Moreover, the "arm" recited in independent claims 1 and 26 is described as having an end "adapted for insertion in an aperture in the first edge flange of the repair clamp." In Bosco, the distal ends of claws 14 and 15 are not shown as disposed in, nor could they be inserted in, any of the apertures in the first and second interlocking members 4 and 5. Opposed ends of the flexible metal strap 3 are disposed in the slots 7 in the two interfitting members 4 and 5, so these slots could not receive one of Bosco's claws. Moreover, each of Bosco's claws 14, 15 includes a pair of spaced ends for

engaging the spaced outer lugs 10 and 8 respectively disposed on the two interlocking members 4 and 5. This pair of claws is not adapted for insertion in any of the aligned apertures 7 and 11 respectively disposed in interfitting members 4 and 5 as the clamp's flexible metal strap 3 is inserted through apertures 7 and locking pin 18 is inserted through aligned apertures 11. Even if the claws of Bosco could engage apertures in the two interfitting members of the clamp, the adjustable feature would still be in the clamp and not in apparatus for installing the clamp, as claimed.

In an attempt to show an adjustable feature in apparatus for installing a clamp, which is not shown in either of the references, the examiner relies upon the patent to Murray which is not directed to apparatus for installing any kind of clamp, but rather is directed to the clamp itself. Murray does not disclose apparatus for installing a repair clamp on a pipe, but rather discloses a clamp intended to hold together the separable parts of a concrete mold, such as the type of concrete mold disclosed in Bosco. The Murray concrete mold clamp is not designed for, or capable of, installing another clamp on an object, or body. Also, Murray is not intended for, nor is it capable of, drawing together two objects or two parts of the same object as is the apparatus recited in pending independent claims 1 and 26. The Murray clamp serves the function of "clamping and retaining the mold parts or sections of a mold in fixed and spaced relation." See page 1, lines 1-5. Even if the concrete mold clamp of Murray is described in terms of apparatus for installing a clamp (as the examiner has attempted to do), which it is not, fundamental differences between structure and operation of Murray and the claimed repair clamp installation apparatus are clearly evident, as discussed below.

The Examiner relies upon the patent to Murray as disclosing apparatus having an adjustable mechanism or a movable member as respectively recited in independent claims 1 and 26 to accommodate a range of sizes of the repair clamp. The Examiner specifically relies upon the combination of Murray's elongated aperture 17 having spaced notches 18 and a screw, or bolt, 20 with a winged nut 21 disposed in the clamp's lever 15. However, there are various structural and operational details of the Murray patent which distinguish it from the claimed invention. For example, pending independent claims 1 and 26 recite that when the body portion of the apparatus is pivotally displaced about the arm and clasp from a first position to a second position, the clamp's edge flanges, which are engaged by the ends of the claimed arm and clasp, are drawn together. This is not the case in Murray, where pivoting displacement of lever 15 about pin 16 connecting the lever to a first jaw member 5 does not draw the first and second jaw members 5 and 6 together. Pivoting displacement of Murray's lever 15 about the end of first jaw member 5 causes a corresponding pivoting displacement of link lever 19 about the end of the second jaw member 6, but this does not draw the first and second jaw members toward each other. The spacing between the first and second jaw members is fixed by the position of pin 1 in the elongated aperture 9 in shank 8. Moving Murray's clamp to the configuration shown in FIG. 1 does not move the first and second jaw members 5, 6 together, nor does it draw together opposed side wall members 24 and 25 of the concrete form, it merely locks the clamp's first and second jaw members in fixed, spaced relative position to maintain the mold parts or sections in fixed, spaced relation. See page 1, lines 1-14. Thus, this same pivoting displacement of Murray's lever 15 would not draw together two objects engaged by the first and second jaw

members 5 and 6 of the Murray clamp as recited in claims 1 and 26. Moreover, if Murray were combined with Bosco as suggested by the Examiner, the pivoting coupling of Murray's link lever 19 to the second jaw member 6 would not permit the Bosco clamp to operate as disclosed in Bosco because there then would be three pivoting couplings between Bosco's first claw 14 and its lever arm 13 which would prevent Bosco's first and second claws 14, 15 from drawing the clamp's interlocking members 4 and 5 together. In other words, to incorporate the structure of the Murray clamp relied upon by the Examiner in rejecting the pending claims in the Bosco tool would require the incorporation of a multiple hinge coupling in Bosco's claw 15 which is not shown in Bosco and which would prevent this reference from operating as intended.The combination suggested by the examiner would thus not operate as the apparatus recited in pending independent claims 1 and 26.

The discussion above distinguishes independent claims 1 and 26 from the combination of the Bosco and Murray references cited by the examiner. Thus, the rejection of claims 1 and 26 as well as the rejection of dependent claims 2-25 should be withdrawn. However, because many of the details recited in the various dependent claims also are neither disclosed, nor even suggested, in either of the cited references, the following discussion is directed to differences between the recitations of various dependent claims and the disclosures of the two cited references.

Claim 2

In rejecting claim 2, the examiner alleges that Bosco discloses a clasp having a first end engaging an outer edge of the repair clamp's second edge flange and a second opposed end pivotally coupled to the body portion of the apparatus. As pointed out above, Bosco's form

clamp is adjustable by varying the length of the flexible metal strap element 3 between the clamp's interlocking members 4 and 5. The apparatus for installing the clamp disclosed in Bosco and referred to by the examiner in rejecting claim 2 is not adjustable. Therefore, there is no capability in the Bosco tool to adjust the spacing between Bosco's claws 14 and 15 to accommodate a range of sizes of the Bosco form clamp as in the claimed invention.

Claim 3

In rejecting claim 3, the examiner states that Bosco in view of Murray discloses the first end of the clasp including a recessed slot adapted to receive the outer edge of the repair clamp's second edge flange. Because Murray is directed to a concrete mold clamp, it does not disclose any structure for engaging an outer edge of another clamp. In combining Bosco and Murray, the examiner ignores Murray's link lever 19 pivotally coupled to both handle 15 and to the second end of jaw 6 for pivotally coupling these two members. Incorporating the equivalent of Murray's link lever 19 between the inner end of Bosco's claw 15 and Bosco's lever arm/handle 13 would render the Bosco tool incapable of operating as intended because of the incorporation of an additional pivot point (pivot pin 11 in Murray) between Bosco's claw 15 and Bosco's lever arm/ handle 13.

Claim 4

In rejecting claim 4, the examiner states Bosco in view of Murray disclose a first pivot pin coupling the second end of the clasp to the body portion. However, in combining Murray with Bosco in rejecting the pending claims, the examiner ignores the three pivot pin coupling between Murray's first and second jaw members 5 and 6 which if incorporated between Bosco's

first and second claws 14 and 15 would prevent Bosco from drawing together the two slides 4 and 5 of Bosco's concrete form clamp.

Claim 5

In rejecting claim 5, the examiner states that Bosco in view of Murray disclose a second pivot pin coupling the first end of the arm to the body portion. However, Bosco's claw 15 connected to lever arm 13 intermediate the first and second opposed ends thereof is neither intended for nor disclosed as "adapted for insertion in an aperture in the first edge flange of the repair clamp." The two claws 14 and 15 of Bosco are clearly designed for and disclosed as engaging outer edges of a slide member of a clamp. Murray, being a clamp itself, also is not described as having any structure "adapted for insertion in an aperture" in another clamp, as claimed.

The remaining dependent claims also recite patentable subject matter, particularly in view of the allowability of the independent claim from which each depends, but for the sake of brevity and cost, the remaining dependent claims are not discussed in detail herein. It should be noted that in rejecting independent claim 26 and all of the dependent claims, the examiner has not identified where in either Bosco or Murray the additional elements recited in these dependent claims are disclosed. The examiner merely repeated the recitation in each dependent claim in the rejection of each of these claims.

The claims stand rejected as unpatentable over the combination of Bosco and Murray. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on applicant's disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).* There is no suggestion in either Bosco or Murray that it be combined with the other reference to arrive at the claimed invention. First, neither Bosco nor Murray has any relationship to any type of repair clamp, much less a repair clamp for a pipe. Second, neither Bosco nor Murray disclose an adjustable tool for installing anything. There is no suggestion in Bosco that the tool for use with a concrete form is adjustable, could be made adjustable, or that it would be desirable to make it adjustable. Furthermore, there is no suggestion in either reference to combine it with the other, nor is there any reasonable expectation of success in either of these references that it could be successfully combined with the other to arrive at the claimed repair clamp installation apparatus. Bosco's tool is designed for use with the concrete form disclosed in that patent and would not work with the concrete form clamp of Murray. The Murray concrete form clamp clearly does not need a tool for installing the clamp on a concrete form and could not be installed using Bosco's tool. These two references teach away from one another because one concrete form requires an installation tool while the other does not. The combination of these references suggested by the examiner would not result in the claimed invention. A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding. See *In re Lee, 61*

USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the Examiner can satisfy the requirements for a showing of obviousness of a combination only by showing some objective teaching in the prior art, or knowledge generally available to one of ordinary skill in the art, that would lead that individual to combine the relevant teachings of the references. *In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).* There is no suggestion in either of these cited references of apparatus for installing a repair clamp on a pipe or for an adjustable device for installing any type of clamp on anything. The combination of references relied upon by the Examiner must disclose all of the claimed elements in an obviousness rejection. *Motorola v. Interdigital Technology Corp., 43 USPQ2d 1481, 1490 (Fed. Cir. 1997).* Because this is not the case here, the §103(a) rejection based on Bosco and Murray must fail.

The initial burden is on the Examiner to provide some suggestion in the prior art of the desirability of doing what the inventor has done. In the present rejection, the Examiner has merely located two isolated references which allegedly disclose separate portions of Applicant's invention. The Examiner has failed to provide any support that either of the cited references expressly or impliedly suggests the claimed invention. More specifically, neither Bosco nor Murray disclose or suggest adjustable apparatus for installing a repair clamp on a pipe capable of use with repair clamps of various sizes and pipes of various diameters. Neither of these references disclose this essential feature of the claimed invention and thus neither of these references qualifies as either a §102 or a §103 reference. Nor has the Examiner presented a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious in light of the teachings of the references themselves. The

Examiner is required to set forth a convincing line of reasoning leading to the obvious combination of the cited references. *Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).*

With this amendment, all of the pending claims are believed to define patentable subject matter. Therefore, reconsideration and allowance of the pending claims is respectfully solicited.

Respectfully submitted,

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Thomas E. Hill

Thomas E. Hill, Reg. No. 28,955
Attorney for Applicant
EMRICH & DITHMAR LLC
125 S. Wacker Drive, Suite 2080
Chicago, IL 60606-4401
Tel: 312-663-9800
Fax: 312-633-9822
Email: emrichtom@aol.com